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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,433	11/12/2003	Timothy D. Smythe JR.		7143

7590 02/24/2005  
Clifford Kraft  
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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/706,433

**Applicant(s)**

SMYTHE, TIMOTHY D.

**Examiner**

Yvonne M. Horton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-20 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9-13 is/are rejected.
- 7) ☒ Claim(s) 6-8, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/11/04</u> & <u>11/12/03</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9,10,11 are provisionally rejected under the judicially created doctrine of double patenting over claims 1,5,6 of copending Application No. 10/200,478 in view of US Patent #4,313,991 to LAMB. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

A rigid member having finishing paper layer on an external surface to receive a paint or texture. 10/200,478 discloses the basic drywall product except for the use of patterns formed on an interior. LAMB discloses that it would have been obvious to add patterns on an interior surface of the rigid member. It would have been obvious

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to one having ordinary skill in the art at the time the invention was made to provide the drywall device of a 10/200,478 with the protrusions of LAMB in order to improve adhesion or securing of the drywall device to the wall.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application.

### ***Claim Objections***

Claims 13-15 recite the limitation "the pointed protrusions" in line 2. There is insufficient antecedent basis for this limitation in the claim. Until further clarification, the claim has been examined as there merely being "protrusions".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #4,863,774 to TUCKER. TUCKER inherently discloses a method of making a drywall product (14,40,60,80) including the steps of extruding an elongate semi-rigid support member (44,64) to form a pair of flanges (not labeled) with a grooved hinge (see figure 5) running along a center-line thereof; wherein the support members (14,40,60,80) includes a fibrous outer layer (42,62,82); and producing a plurality of protrusions (20)

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on an inner surface of the support members (44,64) to receive drywall mud (column 2, lines 57-60).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,090,087 to MILLER in view US Patent #4,313,991 to LAMB. MILLER discloses a rigid member (10) having a finishing paper layer (13) that can be painted or spackled, column 3, lines 44-48. MILLER discloses the basic claimed drywall device except for the inclusion of a pattern of protrusions and except for the rigid member being plastic and tapered. LAMB teaches that it is known in the art to form a drywall member (12) out of plastic, column 3, line 30; tapered edges (16,18), column 2, lines 43-44; and a pattern of protrusions (20), see figure 3. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the rigid

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member of MILLER out of plastic and to provide the rigid member of MILLER with the protrusions and tapered edges of LAMB in order to form a drywall member that is not corrosive, and that enables the member to be firmly secured flush with the wall surface. Regarding claim 10, MILLER, as modified by LAMB teaches a rigid plastic member. However, LAMB does not specify the type of plastic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material on the basis of its suitability for the use intended is an obvious matter of design choice. For instance, the selection of material used to form the rigid member depends upon the strength needed in the member and environment of the wall in which the device will be attached. Perhaps one type of plastic might adhere to a certain wall surface better than another type of plastic. In reference to claim 11, MILLER, as modified by LAMB, teaches the use of a kraft paper. However, there is no teaching of "cup stock" paper. Again, the selection of a known material on the basis of its suitability for the use intended is an obvious matter of design choice. Regarding claim 12, the paper finishing layer (13) of MILLER extends beyond the edges (16,18) of the rigid member (12), see the figures. In reference to claim 13, the protrusions (20) run vertically along the length of the drywall member of LAMB as positioned on a wall.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,863,774 to TUCKER. TUCKER discloses the basic claimed method except for tapering the flanges. Regarding claim 2, tapering is old and very well known in the art. Although TUCKER does not taper his flanges, it would have been obvious to one having ordinary skill in the art at the time the invention was made to taper the flanges of

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TUCKER in order to ensure that the drywall device fits flush against the wall surface thereby making it easier to provide a smooth exterior wall finish. In reference to claim 3, the finishing layer (50) extends beyond the support member (42).

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,863,774 to TUCKER. TUCKER discloses the basic claimed method except for explicitly detailing that the support member is a polystyrene plastic and except for explicitly detailing that the finishing paper is "cup stock" paper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material on the basis of its suitability for the use intended is an obvious matter of design choice. For instance, the selection of material used to form the rigid member depends upon the strength needed in the member and environment of the wall in which the device will be attached. Perhaps one type of plastic might adhere to a certain wall surface better than another type of plastic. In reference to claim 11, MILLER, as modified by LAMB, teaches the use of a kraft paper. However, there is no teaching of "cup stock" paper. Again, the selection of a known material on the basis of its suitability for the use intended is an obvious matter of design choice.

***Allowable Subject Matter***

Claims 6-8 and 14-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims:


Claims 16-20 are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-1909. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703) 308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
YMH  
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2/22/05